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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,031	10/31/2003	John Deryk Waters .	300203673-2	1094
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HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
			EXAMINER GOLDBERG, BRIAN J	
			ART UNIT 2861	PAPER NUMBER

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No. 10/697,031	Applicant(s) WATERS, JOHN DERYK	
	Examiner Brian Goldberg	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 14 and 24 is/are allowed.
- 6) ☒ Claim(s) 13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 18 states that "the movement of the memory tag dispenser relative to the base medium is...substantially perpendicular to the first axis." This is already stated in the last step of claim 15.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. in view of Hohberger et al.

4. Regarding claim 13, Fox et al. disclose an "apparatus for printing and memory tag application onto a base medium (100 of fig 2), the apparatus having a print head (12 of fig 2) for printing onto the base medium, and a memory tag dispenser (34 of fig 2) movable relative to the base medium for applying memory tags to the base medium wherein the base medium is moved along a first axis (right-to-left axis of fig 2) through or past the apparatus, the print head does not move (col 6 ln 35-37)." Thus Fox et al.

meet the claimed invention except "the memory tag dispenser moves back and forth along a third axis which is substantially perpendicular to the first axis."

5. Hohberger et al. teach "the memory tag dispenser (320, 330 of Fig 21) moves back and forth along a third axis (up and down in figs 21 and 22) which is substantially perpendicular to the first axis (left to right in fig 21)." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the memory tag dispenser movable substantially perpendicular to the direction the base medium moves. One would have been motivated to so modify the memory tag application system of Fox et al. by making the dispenser movable for the benefit of gaining the ability to increase or decrease the distance from the dispenser to the medium, which increases or decreases the time for the tag to move from dispenser to medium.

6. Regarding claim 15, Fox et al. disclose "a method of printing onto a base medium (100 of fig 2) and applying a memory tag (112 of fig 5) to the base medium comprising the steps of: i) feeding the base medium along a first axis (right-to-left axis of fig 2) past a print head (12 of fig 2); ii) printing onto the base medium (col 6 ln 38-41); iii) feeding the base medium past a memory tag dispenser (34 of fig 2)." Thus Fox et al. meet the claimed invention except "iv) moving the memory tag dispenser relative to the base medium and essentially perpendicular to the first axis and applying a memory tag to the base medium at a desired location."

7. Hohberger et al. teach "iv) moving the memory tag dispenser (320, 330 of Fig 21) relative to the base medium (14 of Fig 21) and essentially perpendicular (up and down direction in fig 21) to the first axis (left to right in fig 21) and applying a memory tag to

Art Unit: 2861

the base medium at a desired location (see figs 21-23)." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the memory tag dispenser movable essentially perpendicular to the direction the base medium moves. One would have been motivated to so modify the memory tag application system of Fox et al. by making the dispenser movable for the benefit of gaining the ability to increase or decrease the distance from the dispenser to the medium, which increases or decreases the time for the tag to move from dispenser to medium.

8. Regarding claim 16, Fox et al. further disclose "moving the print head (12 of fig 2) relative to the base medium (col 6 ln 35-37)."

9. Regarding claim 17, Fox et al. further disclose "the movement of the print head (12 of fig 2) relative to the base medium is along a second axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis (right-to-left axis of fig 2)." The first axis can be considered the x-axis while the second axis can be considered the z-axis. These axes are perpendicular, by definition.

10. Regarding claim 18, Hohberger et al. further teach "wherein the movement of the memory tag dispenser (320, 330 of Fig 21) relative to the base medium (14 of Fig 21) is along a third axis (up and down direction in fig 21) substantially perpendicular to the first axis (left to right in fig 21)."

11. Regarding claim 19, Fox et al. further disclose "it further comprises the step of writing data to the memory tag, prior to applying it to the base medium (col 7 ln 26-28)."

Art Unit: 2861

12. Regarding claim 20, Fox et al. further disclose "it further comprises the step of reading the data on the memory tag and checking it against the data written to it (col 7 ln 58-61)."

13. Regarding claim 21, Fox et al. further disclose "the memory tag (112 of fig 5) is applied to the base medium (100 of fig 2)." Thus, Fox et al. meet the claimed invention except "at a location printed with a preselected icon."

14. Hohberger et al. teach providing a printed preselected icon (248 of fig 18) at a location where the memory tag is applied. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply the memory tag to the base medium "at a location printed with a preselected icon." One would have been motivated to so modify Fox et al. for the benefit of enhancing the aesthetic appearance of the base medium or having a uniform memory tag location for a set of base medium.

15. Regarding claim 22, Fox et al. further disclose "a plurality of memory tags are applied to the base medium (see col 8)." There are many tags (112 of fig 5) applied to the base medium (100 of fig 2).

16. Regarding claim 23, Fox et al. disclose "a method of printing onto a base medium (100 of fig 2) and applying a memory tag (112 of fig 5) to the base medium comprising: i) feeding the base medium along a first axis (right-to-left axis of fig 2) past a print head (12 of fig 2); ii) moving the print head relative to the base medium (col 6 ln 35-37) along a second axis (into and out of the page axis of fig 2) substantially perpendicular to the first axis; iii) printing onto the base medium (col 6 ln 38-41); iv) feeding the base medium past a memory tag dispenser (34 of fig 2)." Thus Fox et al. meet the claimed

Art Unit: 2861

invention except "v) moving the memory tag dispenser relative to the base medium along a third axis substantially perpendicular to the first axis; and vi) applying a memory tag to the base medium at a desired location."

17. Hohberger et al. teach "v) moving the memory tag dispenser (320, 330 of Fig 21) relative to the base medium (14 of Fig 21) along a third axis (up and down direction in fig 21) substantially perpendicular to the first axis (left to right in fig 21); and vi) applying a memory tag to the base medium at a desired location (see figs 21-23)." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the memory tag dispenser movable essentially perpendicular to the direction the base medium moves. One would have been motivated to so modify the memory tag application system of Fox et al. by making the dispenser movable for the benefit of gaining the ability to increase or decrease the distance from the dispenser to the medium, which increases or decreases the time for the tag to move from dispenser to medium, allowing application of the memory tag at a desired location.

Allowable Subject Matter

18. Claims 1-12, 14, and 24 are allowed.

19. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not disclose or suggest "the memory [or RFID] tag dispenser is movable ... in order to enable application of memory tags to the base medium at desired locations" in combination with the remaining claim elements set forth in claim 1, and its respective dependent claims, and the RFID tag dispenser moving back and forth along a third axis, the second and third axes being substantially perpendicular to the

Art Unit: 2861

first axis and parallel to each other in combination with the remaining claim elements set forth in claims 14 and 24.

Response to Arguments

20. Applicant's arguments with respect to claims 13 and 15-23 have been considered but are moot in view of the new ground(s) of rejection.

21. Applicant's arguments, see page 1 of the remarks, filed 11/8/2005, with respect to claims 14 and 24 have been fully considered and are persuasive. The rejection of claims 14 and 24 has been withdrawn.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2861

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goldberg whose telephone number is 571-272-2728. The examiner can normally be reached on Monday through Friday, 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Talbott can be reached on 571-272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BJG

December 23, 2005

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